REMARKS

Claims 1, 4-10, 15-20, 30-40, 43-47, 52, and 53 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 45-47 Under 35 U.S.C. §101

Claims 45-47 stand rejected under 35 U.S.C. §101. It is respectfully submitted that this rejection is improper and should be withdrawn for at least the following reasons. The subject claims fall within the statutory classes for inventions.

> Patentable subject matter is not limited to tangible articles or objects, but includes intangible subject matter, such as data **or signals**, representative of or constituting physical activity or objects. *In re Warmerdam*, 33 F.3d 1354, 1360, 31 U.S.P.Q.2D (BNA) 1754, 1760 (Fed. Cir. 1994) (citing *In re Schrader*, 22 F.3d 290, 295 (Fed. Cir. 1994) (emphasis added). Title 35, section 101, explains that an invention includes "any new and useful process, machine, manufacture or composition of matter."... Without question, ***software code alone qualifies as an invention eligible for patenting under these categories***, at least as processes. *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338 (Fed. Cir. 2005). (Emphasis added).

The Examiner has conceded that claims 45-47 produce a useful, concrete and tangible result, but argues that the indicated claims do not fall within one of the four statutory classes. As previously submitted, pursuant to *In re Warmerdam*, signal claims are within the province of statutory subject matter. Moreover, software code alone (*e.g.*, computer executable instructions) is sufficient to insure that a claim is within a statutory category. Therefore, even if the Examiner were correct in assuming signal claims are not statutory subject matter, the inclusion of something that is not by itself statutory does not render the entire claim non-statutory. Accordingly, this rejection of claims 45-47 should be withdrawn.

II. Rejection of Claims 1-6, 8-10, 43, 44, 52 and 53 Under 35 U.S.C. §102(e)

Claims 1-6, 8-10, 43, 44, 52 and 53 stand rejected under 35 U.S.C. §102(e) as being anticipated by Jain, *et al.* (U.S. 6,567,980). Withdrawal of this rejection is respectfully requested

for at least the following reasons. Jain, *et al.* fails to teach or suggest each and every limitation as recited in the subject claims.

> A single prior art reference anticipates a patent claim only if it expressly or inherently describes ***each and every limitation set forth in the patent claim.*** *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). ***The identical invention must be shown in as complete detail as is contained in the ... claim.*** *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Independent Claims 1 and 6

The claimed invention relates to viewing ***annotated digital media*** and non-linear viewing of related *annotated media.* In particular, independent claim 1 (and similarly independent claim 6) recites, "a metadata generator that produces metadata associated with the selected scene and ***annotates the selected scene with the metadata***" and "an organizer that places the selected ***annotated scene*** in a media store to facilitate non-linear viewing of one or more scenes". Jain, *et al.* does not disclose or suggest these novel aspects of applicants' claimed invention.

Rather, Jain, *et al.* discloses a multimedia cataloger that extracts metadata from video (col. 2, lines 18-20), and commits the metadata to the Metadata Track Index Manager and/or a track index (col. 8, lines 54-59; col. 9, lines 11-12). Jain, *et al.* neither annotates digital media with metadata, nor stores annotated media as recited in the subject claims. Instead, the reference extracts metadata from the media, and stores that metadata separately from the media. (*See e.g.*, Fig. 1, items 130, 140). Consequently, the non-linear access to various segments of the media requires an intermediate index and is therefore distinguished from the subject invention.

At page 2 of the Advisory Action (dated June 1, 2005), the Examiner incorrectly asserts that extracting metadata from media is equivalent to annotating the media with metadata. It is readily apparent that media directly annotated with metadata (*i.e.*, annotated media) is distinct from unannotated media with an index of associated metadata. For example, it is cumbersome to store media and metadata separately and also inefficient to consult an intermediary to provide non-linear access, when, as provided for in the subject invention, annotated media combines the

media with the metadata for manageable storage and for rapid non-linear access. Jain, *et al.* fails to teach or suggest a metadata generator that produces metadata associated with the selected scene and ***annotates the selected scene with the metadata***. The reference also fails to teach or suggest an organizer that places the selected ***annotated scene*** in a media store to facilitate non-linear viewing of one or more scenes. Accordingly, the identical invention is not shown in as complete detail as is contained in the subject claims, and this rejection should be withdrawn.

Independent Claims 43 and 44

Independent claim 43 recites, "a second field that holds a metadata item related to the media item, where the metadata facilitates locating a related media item by ***annotating the related media with metadata***". Independent claim 44 recites, "in response to the interface element selection signal, ***initiating processing of related media by the metadata generator*** to facilitate non-linear viewing of media based, at least in part, upon stored metadata", wherein the metadata generator as described by the disclosure annotates media with metadata. As detailed *supra*, Jain, *et al.* does not provide for annotating the related media with metadata, and merely extracting metadata that is associated with the media is insufficient to read upon the claimed invention. Accordingly, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 45-47 Under 35 U.S.C. §102(e)

Claims 45-47 stand rejected under 35 U.S.C. §102(e) as being anticipated by Morris (U.S. Patent Application: 2002/0088000). Withdrawal of this rejection is respectfully requested for at least the following reasons. Morris fails to teach or suggest each and every limitation set forth in the subject claims.

Independent claims 45 and 46 recite, "a second field that stores ***a metadata key*** that ***identifies an annotating metadata associated with the clip*** identified by the clip identifier." Independent claim 47 recites, "a second field that ***stores a requested user action*** ... and a third field that stores metadata...where ***the metadata is employed to adapt one or more clips according to the requested user action***." Morris does not disclose or suggest these limitations.

Morris relates to a method and system for controlling access to image metadata. Digital images captured and stored on an internal memory of a digital camera can be uploaded to a database for storing the images [and related metadata]. (Paragraphs 0017-0018). This related

metadata is stored within the image file in individual image tags. (Fig. 2, item 60; paragraph 0020). The tags include system tags that describe such things as focus setting, aperture setting, *etc.* (Fig. 3, item 64; paragraph 0021), and user tags that are used to store labels such as "birthday" or "vacation" (Fig. 3, item 66; paragraph 0022). Accordingly, user tags neither ***store a requested user action***, nor are the metadata ***employed to adapt one or more clips according to the requested user action***, as recited in the subject claims. Rather, the reference stores only labels, and these labels are merely descriptive, without any functional ability disclosed to adapt a clip according to a user action.

Furthermore, the data structure of Morris stores actual metadata, not ***a metadata key***, as recited in independent claims 45 and 46. Morris discloses an unsophisticated method of storing individual image files and is silent on whether metadata for one image can relate to other metadata (*e.g.*, metadata in the same or a different image). Therefore, contrary to the Examiner's remarks at page 13 of the Final Office Action (dated June 1, 2005), "identification of metadata" is insufficient to read upon a metadata key because a key has dynamic, relational aspects associated with other data elements that is more than mere identification. The simplistic disclosure of the reference does not contemplate these relational aspects associated with a metadata key and, hence, does not anticipate the subject claims. Accordingly, this rejection of independent claims 45-47 should be withdrawn.

IV. Rejection of Claim 7 Under 35 U.S.C. §103(a)

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Jain, *et al.* (U.S. 6,567,980) in view of Duncombe (U.S. 6,813,745). Withdrawal of this rejection is respectfully requested for at least the following reasons. Claim 7 depends directly from independent claim 6, and Duncombe, which relates to a media system for storing media files and a media organization file, does not make up for the aforementioned deficiencies of Jain, *et al.* with respect to claim 6. Accordingly, this rejection should be withdrawn.

V. Rejection of Claims 15-20 and 30-40 Under 35 U.S.C. §103(a)

Claims 15-20 and 30-40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jain, *et al.* in view of Duncombe (U.S. 6,792,573). Withdrawal of this rejection is respectfully requested for at least the following reasons. Jain, *et al.*, alone and/or in combination

with Duncombe, does not teach or suggest all limitations set forth in the subject claims. Additionally, there is no motivation to combine the teachings of Jain, *et al.* with those set forth in Duncombe.

> To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination ***and the reasonable expectation of success*** must be found in the prior art and not based on the Applicants' disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants' claimed invention relates to annotating digital media with metadata to facilitate non-linear viewing of related scenes that are annotated with metadata. In particular, independent claim 15 (and similarly independent claims 30 and 35) recites, "a scene retriever that retrieves one or more ***annotated*** scenes" and "a playlist generator that evaluates the one or more ***relationships*** and produces ***a playlist*** of related scenes". The Examiner concedes that Jain, *et al.* does not teach or suggest every limitation, but contends that Duncombe will cure the deficiencies.

However, as detailed above, independent claims 15, 30 and 35 recite limitations similar to independent claim 6 as originally filed, and which is not disclosed or suggested by Jain, *et al.* In particular, the instant claims recite annotated media (*e.g.*, scenes, video segments, and displayable items). Duncombe does not make up for this deficiency of Jain, *et al.*, and these claims are, therefore, believed to be allowable over the cited references.

Furthermore, the Examiner states at page 2 of the Advisory Action that the concept from Duncombe of utilizing user feedback to create a playlist can be combined with Jain, *et al.* to render the claims obvious. While applicants' representative continues to maintain such a combination is impermissible because the modifications render the references inoperable for their intended purposes, it is further submitted that the proposed combination does not teach or

suggest every feature of the claims. In particular, Duncombe does not contemplate metadata or annotated media. Accordingly, the concept of a playlist based upon a relationship between metadata or associated with annotated media is not taught or suggested, and the Examiner has failed to provide motivation from the reference that relationships between metadata used in other aspects of Jain, *et al.* would be applied to the playlist from Duncombe. It is not enough to simply postulate that the combination could be made. *See In re Fritch*, 972 F.2d 1260, 1265-66 (Fed. Cir. 1992) (holding that flexibility shown in one aspect of the reference does not imply extending that flexibility to the entire device." The Examiner has not provided a reasonable motivation from the reference to sustain the combination. Thus, this rejection of independent claims 15, 30, and 35 should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP304US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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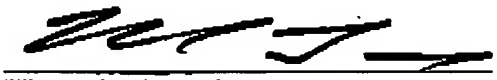

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